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K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690			EXAMINER CHAWLA, JYOTI	
			ART UNIT 1781	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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chicago.patents@klgates.com

Office Action Summary	Application No. 10/598,444	Applicant(s) AMBROGI ET AL.	
	Examiner JYOTI CHAWLA	Art Unit 1781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/22/2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's submission of remarks filed on 7/22/2011 has been entered. No claim amendments have been submitted. Claims 1-17 (as submitted on 2/16/2011) are pending and examined in the current application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

A) Claims 1-6, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over IDS reference to Kahn et al (US 4552773), hereinafter Kahn in view of the combination of Hansen (US 5127956) and Dea et al (GB 1508437), hereinafter Dea.

The references and rejection are incorporated herein and as cited in the office action mailed April 5, 2011.

Regarding **claims 1 and 12**, Kahn discloses whipped ice cream (Column 1, line36-38), that maintains a stable volume and is soft and spoonable at a temperature of 0°F, or about -18 °C (Column 1, lines 37-48), i.e., temperature range overlaps the claimed

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range of an aerated frozen confection which is soft down to a storage temperature in home freezers of -18 °C or less.

Regarding the composition of the frozen confection Kahn discloses 40-70% water (Column 2, lines 14-17), which includes claimed range of 50 to 70% water for claims 1 and 12.

Kahn also teaches of about 3-10% fat (Column 2, line 17-19), which falls in the claimed range of 5 to 20% fat for claims 1 and 12.

Regarding the amount of polyol, Kahn discloses polyols or polyhydric alcohols including glycerol in an amount of 0.5 to 6% (Column 7, lines 10-20) (as recited in **amended claim 1 and claims 3 -4 and new claim 17**). Kahn discloses of replacing 1-35% of the sugars (Column 6, lines 34 to 65), where the sugars are about 1/3 to 4/7 of the amount of water (based on the relative proportion given of components in Column 2, lines 15-20) and Kahn also provides examples of compositions comprising about 24 % sugars by weight (e.g., see Columns, 8 and 9). Thus as disclosed by Kahn, polyols comprise 1% or more of the confection as recited in claims 1, 4 and 12.

Regarding the limitation of fiber Kahn discloses of polysaccharide stabilizers, which include Carboxymethylcellulose, carrageenan and other polysaccharides, including applicant's disclosed preferred stabilizer gum arabic (Column 4, lines 30-65), which is also known as fibergum from acacia tree, i.e., Kahn discloses of fibers. Regarding the amount of fibers, Kahn discloses of 0.125 to 10% by weight of the final products, which overlaps applicants' recited range of 0.5 to 7% vegetable fiber for claims 1 and 12. Kahn is silent regarding oat or chicory oligosaccharide as the source of fiber (as claimed in claims 1 and 5). However, fibers or oligosaccharides from chicory root were known and available at the time of the invention, as taught by Hansen (see, e.g., Hansen Column 1, lines 5-15 and 48 to 65, Column 3, lines 50-55, 62-67, Column 4, line 5). Hansen also discloses uses of chicory based composition comprising oligosaccharides and states that "The product prepared according to the invention is suitable for the preparation of low-calorie human or animal foodstuffs or beverages by incorporating the product in the foodstuff or beverage." (Column 8, lines 33-36). Hansen also discloses that "Examples

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for products where the mixture is usable include chewing gum, chocolate, **ice cream**, liquorices, cakes, all types of biscuits, canned food, marmalade and jams, lemonade and various other foodstuffs.” (Column 8, lines 37-40). Regarding the benefits of using chicory saccharine composition Hansen discloses “The mixture passes the alimentary tract predominantly without being digested thus providing the organism with a very low amount of calories. The mixture increases the rate with which the food passes the alimentary tract, thus reducing the overall intake of calories.” (Column 8, lines 50-54). Thus, frozen confections comprising non-digestible polysaccharides and oligosaccharides, in the recited amount of the applicant, were known at the time of the invention (Kahn). Chicory as a source of oligosaccharide was known (Hansen). Chicory oligosaccharide was known for its reduced calories and other benefits were known at the time of the invention (Hansen). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kahn in view of Hansen and include chicory based oligosaccharide as a stabilizer in the aerated frozen composition. One of ordinary skill would have been motivated to modify Kahn at least for the purpose of including a source of sweetness that is natural and is predominantly non-digestible, provides very low calories itself and increases rate with which the food passes the alimentary tract, thus reducing the overall intake of calories, as taught by Hansen (Column 8, lines 50-54).

As claimed, Kahn also discloses of composition comprising sugars (Column 5, line 47 to Column 6, line 33), milk proteins (Column 3, lines 45-55), hydrocolloids (Column 4, lines 50-55) and emulsifiers (Column 3, lines 10-45).

Regarding the new limitation of “aerated frozen confection being resistant to shrinkage and soft down to a storage temperature of -18 °C or less”, Kahn discloses of a confection that maintains a stable volume (Column 1, lines 37-48), i.e., the volume of the frozen confection does not change. Kahn also states the freezer temperature of 0°F, or about -18 °C (Column 1, lines 37-48). Kahn teaches soft and spoonable aerated confection comprising polyol in the claimed range and at a temperature of 0°F, or about

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-18 °C (Column 1, lines 37-48). Further, evidence is provided by Dea where frozen confections containing freezing point depressants, like glycerol in applicant's claimed range of 1% or more were known in the art for being spoonable at temperatures of -20 °C, i.e., less than -18 °C as claimed (See Dea, Page 1, lines 35-40, 55-65 and page 2, lines 100-110).

Thus, based on Kahn's disclosure and as evidenced by Dea's disclosure stable spoonability of softness in an aerated frozen confection results from having stabilizers and freezing point depressants like glycerol. Since Kahn as applied above teaches substantially the claimed invention, it follows that frozen aerated confection of Kahn as applied above will also have the softness and spoonability at applicants' recited storage temperature. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention that frozen confection, as disclosed by Kahn will resist loss of volume or shrinkage, when stored at freezer temperatures of -18 °C, as is instantly claimed.

Regarding the overrun, Kahn discloses 70-130% overrun, which includes applicants' recited range of an overrun of 20 to 200% for claims 1 and 12 and 90% to 160% for claim 6.

Regarding the overlapping of ranges between the invention and prior art composition (claims 1-6 and 12) it is noted that in the case where the claimed ranges "overlap or lie inside the ranges disclosed by the prior art" a prima facie case of obviousness exists (In re Wetheim, 541 F2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990)).

Regarding the amount of proteins as recited in **claim 2**, Kahn provides example of a typical product that may contain 5-8% nonfat milk solids and 3-6% of whey protein concentrate and (Column 3, line 66 to Column 4, line 5) which has a total protein solids, in a typical product in the amount of 3-10% or higher, which includes values in applicants' recited range. Regarding the source of the proteins being dairy, Kahn discloses of "dairy-based carriers, such as dairy whey, whey protein concentrate, nonfat

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milk solids, powdered milk and mixtures thereof" (Column 3, lines 50-55) in the final product in a concentration of about 5-25% (Column 3, lines 62-67).

Kahn is silent about the monopasteurized milk, however, applicants' have not clarified as to what is monopasteurized milk, and also have not disclosed any criticality of utilizing monopasteurized milk for the purpose of making the aerated confection. Thus, milk protein obtained from monopasteurized milk is also milk protein, i.e., functional equivalent of milk protein as taught by Kahn. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute one art recognized functional equivalent (i.e., milk protein) for another (i.e., milk protein from monopasteurized milk) in the frozen aerated confection as disclosed by Kahn, depending on milk protein from which source was more easily available and affordable at the time the invention was made. One would have been further motivated to include less processed milk protein for the added benefit of reducing the incorporation of highly processed foods in the frozen confection taught by Kahn. Further the applicants are referred to MPEP § 2144.07, *In re Leshin*, 125 USPQ 416 (CCPA 1960), where the Courts have held that the selection of a known material..., which is based upon its suitability for the intended use, is within the ambit of one of ordinary skill in the art.

B) Claims 7-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn (US 4552773), in view of the combination of Hansen (US 5127956), hereinafter Hansen, Dea et al (GB 1508437), hereinafter Dea and IDS reference to Vaghela et al (WO 01/06865), hereinafter Vaghela.

The references and rejection are incorporated herein and as cited in the office action mailed April 5, 2011.

Kahn discloses of components as discussed above regarding claims 1 and 12. Regarding the new limitation of "aerated frozen confection being resistant to shrinkage and soft down to a storage temperature of -18 °C or less", Kahn discloses of a confection that maintains a stable volume (Column 1, lines 37-48), i.e., the volume of

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the frozen confection does not change. Kahn also states the freezer temperature of 0°F, or about -18 °C (Column 1, lines 37-48). Kahn teaches soft and spoonable aerated confection comprising polyol in the claimed range and at a temperature of 0°F, or about -18 °C (Column 1, lines 37-48). Further, evidence is provided by Dea where frozen confections containing freezing point depressants, like glycerol in applicant's claimed range of 1% or more were known in the art for being spoonable at temperatures of -20 °C, i.e., less than -18 °C as claimed (See Dea, Page 1, lines 35-40, 55-65 and page 2, lines 100-110).

Thus, based on Kahn's disclosure and as evidenced by Dea's disclosure stable spoonability of softness in an aerated frozen confection results from having stabilizers and freezing point depressants like glycerol. Since Kahn as applied above teaches substantially the claimed invention, it follows that frozen aerated confection of Kahn as applied above will also have the softness and spoonability at applicants' recited storage temperature. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention that frozen confection, as disclosed by Kahn will resist loss of volume or shrinkage, when stored at freezer temperatures of -18 °C, as is instantly claimed.

Regarding the method for producing an aerated frozen confection comprising the steps of: premixing sugars with fiber (Column 10, lines 1-25), and fat was added to make the premix, which was combined with sugars,, milk components, water flavor and butter (Column 10, table in lines 25-35) heat and mix at high sheer at pasteurizing temperatures 160-170 °F until dissolved, after that fat is added (e.g., see column 10, lines 38-60).

Kahn discloses of high shear mixer, i.e., adding the mixture to an agitated mixing tank, as claimed. Kahn also discloses of heating pasteurizing temperatures 160-170 °F, until dissolved, (Column 10, lines 38-60 and also see Column 7, line 45 to Column 12), i.e., subjecting the mix to a heating step which will hydrate the hydrocolloids, and pasteurizing the heated mix (e.g., Column 7, lines 60-67).

Kahn also discloses of homogenizing the pasteurized mix (Column 8, lines 5-20), and subsequently cooling (column 8, lines 15-18), holding , prior to shipping for 4-24 hours,

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i.e., ageing (Column 8, lines 19-20) and freezing the mix while aerating (Column 8, lines 20-33), and storing in a suitable container (column 9, lines 25-20), i.e., packaging.

The reference however, is silent regarding hardening the packaged product.

Vaghela discloses of a method of making aerated confections, where the aerated product is packaged into containers and hardened (Page 10, lines 16-38). Thus hardening packaged aerated confections at low temperatures was well known in the art of making frozen confections, as taught by Vaghela. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kahn in view of Vaghela and harden the aerated frozen confection. One of ordinary skill would have been motivated to add a method step of hardening to Kahn's process, at least for the purpose of solidifying the frozen confection to a stiffness level so that the confection can hold its shape.

Regarding claim 8 Kahn discloses of pasteurizing while blending and homogenizing pasteurizing temperatures of 160-170 °F, i.e., 71-76 °C (Column 7, lines 60-67) and is silent about the pasteurizing time, however pasteurizing is a known process of heating for a certain period of time to retard microbial spoilage of food and pasteurizing time and temperature ranges are well known to one of ordinary skill in the art. In general, within the temperature ranges, the higher the temperature, the less time a food needs to be exposed to such temperature to be pasteurized. Vaghela discloses of pasteurizing temperature 50-100 °C for 10 seconds to 30 minutes, which includes applicants' recited time and temperature ranges of 24 to 30 seconds at about 90°C to 80 °C. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kahn in view of Vaghela and pasteurize the confection at Vaghela's recommended temperature for recommended time range at least for the purpose of ensuring microbial safety of the aerated food product.

Regarding claim 9, Kahn teaches of two stage homogenizing where the pressure is about 300 to 1000 psi (i.e., about 20-69 bar) and 2000 to 10000 psi (i.e., 137 to 689 bar) (Column 8, lines 5-20),, which includes applicants recited range for pressure of about

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120 to 160 bar. Regarding the temperature of homogenizing Kahn teaches of homogenizing after heating the mixture to pasteurizing temperatures of 160-170 °F, i.e., 71-76 °C (Column 7, lines 60-67) or about 70 °C as claimed.

Regarding claim 10, Kahn discloses freezing step and aerating in a freezer. Kahn discloses the freezer exiting temperature of 68-75 °F, i.e., 20-24 °C (Column 8, line 24-25). The reference also discloses that the confection remains spoonable at freezer temperature of 0°F, or about -18 °C (Column 1, lines 37-48). Thus as disclosed Kahn discloses of freezer temperatures ranging from -18 °C to 24°C. Further freezing confections at temperatures in the claimed range was known in the art. For example Vaghela discloses of drawing temperatures of -4 to -10 °C, for an aerated product (e.g., Page 9, lines 35-40), which includes draw temperature of -5 to -10 °C, as claimed. Thus, freezing an aerated confection at drawing temperatures in the claimed range was known at the time of the invention (Vaghela). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kahn in view of Vaghela and freeze the confection at Vaghela's recommended temperature range to check the hardness of the frozen aerated confection. One of ordinary skill would have been motivated to modify Kahn at least for the purpose of determining the organoleptic properties like smoothness and spoonability along with hardness and aeration quality of the frozen confection at temperatures near or at supermarket and home freezer temperatures.

Regarding claim 11, Kahn discloses of a method of producing confection products comprising the step of using a vegetable fiber selected from the group consisting of oat fibers, fibers extracted from chicory taproots and fibrous from Acacia tree in combination with a polyol to produce an ice confection which contains 5 to 20% by weight fat, as discussed above in rejection A regarding claims 1 and 12. (See Kahn Column 2, line 17-19 for **fat**; Column 6, lines 34 to 65, Column 7, lines 10-20 and Columns 8-9 examples for **polyol**, and Column 4, lines 30-65 polysaccharide stabilizers, including gum arabic or fibergum from acacia tree.

Regarding the **new claims 13-16**, which add the limitation that polyol is glycerol and is added in an amount of 1-5%, Kahn teaches of glycerol in an amount ranging from 0.5 to 6%, which overlaps applicant's claimed ranges recited in the new claims 13-

16. Regarding the overlapping of ranges between the invention and prior art composition it is noted that in the case where the claimed ranges "overlap or lie inside the ranges disclosed by the prior art" a prima facie case of obviousness exists (In re Wetheim, 541 F2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990)).

Response to Arguments

Applicant's arguments filed 7/22/2011 have been fully considered but are not persuasive.

Applicants argue against applied reference to Kahn in view of the combination of Hansen, Dea and Vaghela. Applicant's main argument is that applied references "alone or in combination fail to disclose or suggest an aerated frozen confection being resistant to shrinkage and soft down to a storage temperature of -18°C or less" (Remarks, page 3, last Para lines 1-3). Applicant's support their argument by stating that Kahn, Hansen, Dea and Vaghela fail to disclose a polyol and 0.5 to 7% by weight of vegetable fiber selected from the group consisting of oat fibers, fibers extracted from chicory taproots and combinations thereof" (Remarks, page 3, last Para, lines 3-6). This argument is not persuasive.

Applied references teach the following:

Kahn (**claims 1, 7 and 12**), discloses whipped ice cream (Column 1, line 36-38), that maintains a stable volume and is soft and spoonable at a temperature of 0°F, or about -18 °C (Column 1, lines 37-48) and does not require prolonged thawing period prior to consumption.

Regarding the composition of the frozen confection Kahn discloses

- 40-70% water (Column 2, lines 14-17),
- about 3-10% fat (Column 2, line 17-19), and

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- a polyol including glycerol in an amount of 0.5 to 6% (Column 7, lines 10-20) which overlaps the claimed range of 5 to 20% fat for claims 1 and 12 and also overlaps the polyol limitations of claims 3-4, and claims 13-17
- sugars (Column 5, line 47 to Column 6, line 33), milk proteins (Column 3, lines 45-55), hydrocolloids (Column 4, lines 50-55) and emulsifiers (Column 3, lines 10-45).
- 70-130% overrun, which overlaps applicants' recited range of an overrun of 20 to 200% for claims 1 and 12 and 90% to 160% for claim 6.

All these limitations as taught by Kahn overlap applicants claimed ranges.

Regarding the limitation of fiber Kahn discloses of polysaccharide stabilizers from 0.125 to 10% by weight of the final products, which include Carboxymethylcellulose, carrageenan and other polysaccharides, and gum arabic (Column 4, lines 30-65), which is also known as fibergum from acacia tree, i.e., Kahn discloses of fibers in proportion overlapping the claimed range.

Kahn is silent regarding oat or chicory oligosaccharide as the source of fiber (as claimed in claims 1 and 5). However, fibers or oligosaccharides from chicory root were known and available at the time of the invention, as taught by Hansen (see, e.g., Hansen Column 1, lines 5-15 and 48 to 65, Column 3, lines 50-55, 62-67, Column 4, line 5). Hansen also discloses uses of chicory based composition comprising oligosaccharides and states that "The product prepared according to the invention is suitable for the preparation of low-calorie human or animal foodstuffs or beverages by incorporating the product in the foodstuff or beverage." (Column 8, lines 33-36). Hansen also discloses that "Examples for products where the mixture is usable include chewing gum, chocolate, **ice cream**, liquorices, cakes, all types of biscuits, canned food, marmalade and jams, lemonade and various other foodstuffs." (Column 8, lines 37-40). Regarding the benefits of using chicory composition Hansen discloses "The mixture passes the alimentary tract predominantly without being digested thus providing the organism with a very low amount of calories. The mixture increases the rate with which the food

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passes the alimentary tract, thus reducing the overall intake of calories.” (Column 8, lines 50-54).

Thus, frozen confections comprising non-digestible polysaccharides and oligosaccharides, in the recited amount of the applicant, were known at the time of the invention (Kahn). Chicory as a source of oligosaccharide was known (Hansen). Chicory oligosaccharide was known for its reduced calories and other benefits at the time of the invention (Hansen). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kahn in view of Hansen and include chicory based oligosaccharide as a stabilizer in the aerated frozen composition. One of ordinary skill would have been motivated to modify Kahn at least for the purpose of including a source of sweetness that is natural and is predominantly non-digestible, provides very low calories itself and increases rate with which the food passes the alimentary tract, thus reducing the overall intake of calories, as taught by Hansen (Column 8, lines 50-54).

Regarding the limitation of “aerated frozen confection being resistant to shrinkage and soft down to a storage temperature of -18 °C or less” and applicant’s argument regarding Kahn not teaching said limitation, applicant is referred to previous rejection where it is clearly stated that Kahn discloses of a confection that maintains a stable volume (Column 1, lines 37-48), i.e., the volume of the frozen confection does not change. Kahn also states the freezer temperature of 0°F, or about -18 °C (Column 1, lines 37-48). Kahn teaches soft and spoonable aerated confection comprising polyol in the claimed range and at a temperature of 0°F, or about -18 °C (Column 1, lines 37-48). Further, evidence is provided by Dea where frozen confections containing freezing point depressants, like glycerol in applicant’s claimed range of 1% or more were known in the art for being spoonable at temperatures of -20 °C, i.e., less than -18 °C as claimed (See Dea, Page 1, lines 35-40, 55-65 and page 2, lines 100-110). Since Kahn as applied above in view of Hansen and Dea teaches substantially the claimed invention, it follows that frozen aerated confection of Kahn as applied above will also have similar characteristics of softness, stability of volume and spoonability at applicants’ recited

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storage temperature as the instantly claimed invention. Further, Kahn's disclosure teaches that confection maintains a stable volume (Column 1, lines 37-48), i.e., the volume of the frozen confection does not change or the confection does not shrink, further evidenced by Dea's disclosure that teaches of stable spoonability of softness in an aerated frozen confection resulting from having stabilizers and freezing point depressants like glycerol. Therefore, it would have been reasonable for one of ordinary skill in the art at the time of the invention to expect that aerated confection comprising claimed ingredients in the claimed ranges as taught by Kahn in view of Hansen and Dea will possess similar characteristics of stability of volume i.e., the frozen confection of modified Kahn will resist loss of volume or shrinkage, when stored at freezer temperatures of -18 °C, and as is instantly claimed (emphasis added).

II) Applicant's other arguments against individual references

a) Applicant argues against Kahn that "Kahn fails to provide any measure of indication of the evolution of volume of products over time, in particular when submitted to heat shocks" (Remarks page 4, lines 7-9). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., volume of frozen aerated product when submitted to heat shocks) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response applicant is reminded that applicant's claim as recited uses the transitional term "comprising". It is noted that the transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.

b) Applicant argues against Kahn that "Stabilizer components include polysaccharide stabilizers, preferably CMC in combination with carrageenan. Gums are

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also described as possible stabilizers.” (remarks, page 4, last paragraph to page 5, lines 1-4). This argument is not persuasive and Kahn is still regarded as relevant prior art as Kahn discloses of vegetable based fibers as stabilizers which fall in the category of fibers as claimed. Regarding Kahn’s disclosure including polysaccharide gums like gum acacia attention is invited to applicant’s claim recitation which uses the transitional term “comprising” which is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. Mere disclosure of a stabilizer that does not fall in the claimed list of stabilizers does not disqualify a reference from being applied, where the claimed invention is open to include additional, unrecited elements or method steps. Further attention is directed to applicant’s disclosure which also describes gum acacia as a possible source of fiber (publication of application paragraph 9).

c) Applicant’s argue that Hansen is not applicable. Applicant's support this argument by stating " Although ice creams are mentioned in the list of potential application for using the mixture object of Hansen, soft ice cream is not mentioned. Indeed, the specific problems of spoonability and shrinkage in soft ice cream are not addressed by Hansen” (Page 4, Paragraph 3). This argument is not persuasive as applicant is arguing against references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case the rationale for including Hansen has already been explained in section (I) of response.

d) Applicant also argues that a "skilled person in the art viewing Kahn and looking for an alternative stabilizer than those described in Kahn would have absolutely no reason to believe that the mixture described by Hansen could be used to replace the stabilizers described by Kahn” and “Additionally, even if the skilled artisan were tempted to do so, he would have no reasonable expectation to achieve the results of resistance of shrinkage of the present claims.”(Remarks, page 5, last 2 paragraphs). This

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argument is not persuasive because chicory fiber was known as a stabilizer for foods including ice creams and was also known for its sweet flavor. Thus, one of ordinary skill would have been motivated to modify Kahn at least for the purpose of including a source of sweetness that is natural and is predominantly non-digestible, provides very low calories itself and increases rate with which the food passes the alimentary tract, thus reducing the overall intake of calories, as taught by Hansen (Column 8, lines 50-54).

e) Applicant's argue that Dea is not applicable. Applicant's support this argument by stating "Dea is entirely directed to a spoonable frozen confection using a freezing point depressant like glycerol and containing stabilizer Again, the specific problem of shrinkage in soft ice cream is not addressed by Dea." This argument is not persuasive as applicant is arguing against references individually. See response section (i) for details. Further In response to applicant's argument that references are not applicable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

f) Applicant's other remarks are related to three different ice cream samples, where the photographic results of shrinkage have been reported after 4 cycles of heat shock 9Page 6, last Para to page 8). The results are not persuasive because they do not provide details about the compositions for each of the frozen confections and also do not disclose whether the compositions were all prepared the same way. Applicant's remarks also fail to address whether the stabilizer system was the only difference between the three compositions.

Further the argument presented about example 3 is not persuasive as it is not commensurate in scope with the disclosure of applied references. For example, Kahn discloses polyols or polyhydric alcohols including glycerol in an amount of 0.5 to 6%

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(Column 7, lines 10-20) which overlaps the claimed range and Kahn also teaches of hydrocolloids (Column 4, lines 50-55) and stabilizers, which include Carboxymethylcellulose, carrageenan and other polysaccharides, including applicant's disclosed preferred stabilizer gum arabic (Column 4, lines 30-65), which is also known as fibergum from acacia tree, i.e., Kahn discloses of stabilizers. Further Hansen discloses uses of chicory oligosaccharides (see, e.g., Hansen Column 1, lines 5-15 and 48 to 65, Column 3, lines 50-55, 62-67, Column 4, line 5), wherein examples for products where chicory fiber is used includes **ice cream** (Column 8, lines 33-40). Thus the pictures of ice cream with polyols neither represents Kahn nor Hansen and definitely does not represent a combination as applied in the rejection above. Thus applicant's discussion of three ice creams and showing of picture 3 with loss of volume (shrinkage) is not commensurate in scope with applied references and therefore is not persuasive.

Claims 1-17 remain rejected for reasons of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 8:30 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lawrence Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTI CHAWLA/
Examiner
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